

**REMARKS**

This responds to the Final Office Action mailed on March 17, 2008.

Claims 1, 4, 8, 12, 15, 19, 23, 26, 28, 30, 34, 37 and 41 are amended, claims 3, 9, 14, 20, 25, 31, 36 and 42 are canceled, and no claims are added; as a result, claims 1, 2, 4–8, 10–13, 15–19, 21–24, 26–30, 32–35, 37–41, and 43–48 are now pending in this application.

**Claim Objections**

Claims 4, 8, 15, 19, 26, 30, 37 and 40 were objected to for being improperly dependent on recently cancelled claims. Dependent claims 4, 8, 15, 19, 26, 30, and 37 are amended to depend on standing claims. However, Applicant respectfully submits that dependent claim 40 was not properly objected to because it dependent on standing independent claim 34.

**Claim Amendments**

Applicant is mindful that the proposed amendments cannot, as a matter of right, be entered. Nonetheless, Applicant believes that the proposed amendments require only a cursory review by the Examiner to remove issues from appeal. Specifically, the Independent claims 1, 12, 23 and 34 were amended to include subject matter of cancelled dependent claims 9, 20, 31 and 42 which have already been examined and, accordingly, require no additional search.

**§103 Rejection of the Claims****Concerning claims 1, 4-5, 9-12, 15-16, 20-23, 26-27, 31-34, 37-38 and 42-45:**

Claims 1, 4-5, 9-12, 15-16, 20-23, 26-27, 31-34, 37-38 and 42-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flanagan et al. (U.S. Patent No. 5,966,685; hereinafter “Flanagan”) in view of Gastaldo et al. (U.S. Patent No. 6,473,729; hereinafter “Gastaldo”). Applicant respectfully traverses these rejections.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *In re Young*<sup>1</sup>. Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*<sup>2</sup>. Thus, what is required in the analysis is "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" and not "precise teachings directed to the specific subject matter of the challenged claim" when inferences and creative steps that a person of ordinary skill in the art would employ are taken into consideration<sup>3</sup>. *KSR Int'l Co. v. Teleflex Inc.*

The Final Office Action rejects independent claims 12, 23 and 34 on grounds similar to the grounds for rejection of independent claim 1. Accordingly, Applicant believes that patentability of independent claims 1, 12, 23 and 34 over Flanagan in view of Gastaldo is best understood with respect to independent claim 1.

THE FINAL OFFICE ACTION DID NOT EXPLAIN WHY THE DIFFERENCES BETWEEN THE PRIOR ART AND THE CLAIMED INVENTION WOULD HAVE BEEN OBVIOUS TO ONE OF ORDINARY SKILL IN THE ART.

The Final Office Action admits that Flanagan does not teach "*communicating a plurality of predetermined language constructs to a first entity as a first transmission over said network*" as recited by independent claim 1. To cure this deficiency, the Final Office Action contends that Gastaldo teaches the feature in Figures 5 – 7 and the supporting text<sup>4</sup>.

*Independent claim 1 (as amended) includes the following limitations:*

*communicating a plurality of predetermined language constructs to a first entity as a first transmission over said network; ...*

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<sup>1</sup> 927 F.2d 588,591,18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and *In re Keller*, 642 F.2d 413,425,208 USPQ 87 1, 881 (CCPA 1981)

<sup>2</sup> 401 F.2d 825,826, 159 USPQ 342,344 (CCPA 1968)

<sup>3</sup> 127 S. Ct. 1727,82 USPQ2d 1385,1396 (2007)

<sup>4</sup> The Final Office Action, Page 3

*...said translated language construct is generated and stored, and said correspondence to said selected language construct is defined, prior to communication of said plurality of language constructs to said first entity as said first transmission.*

In regard to the first set of limitations Gastaldo recites:

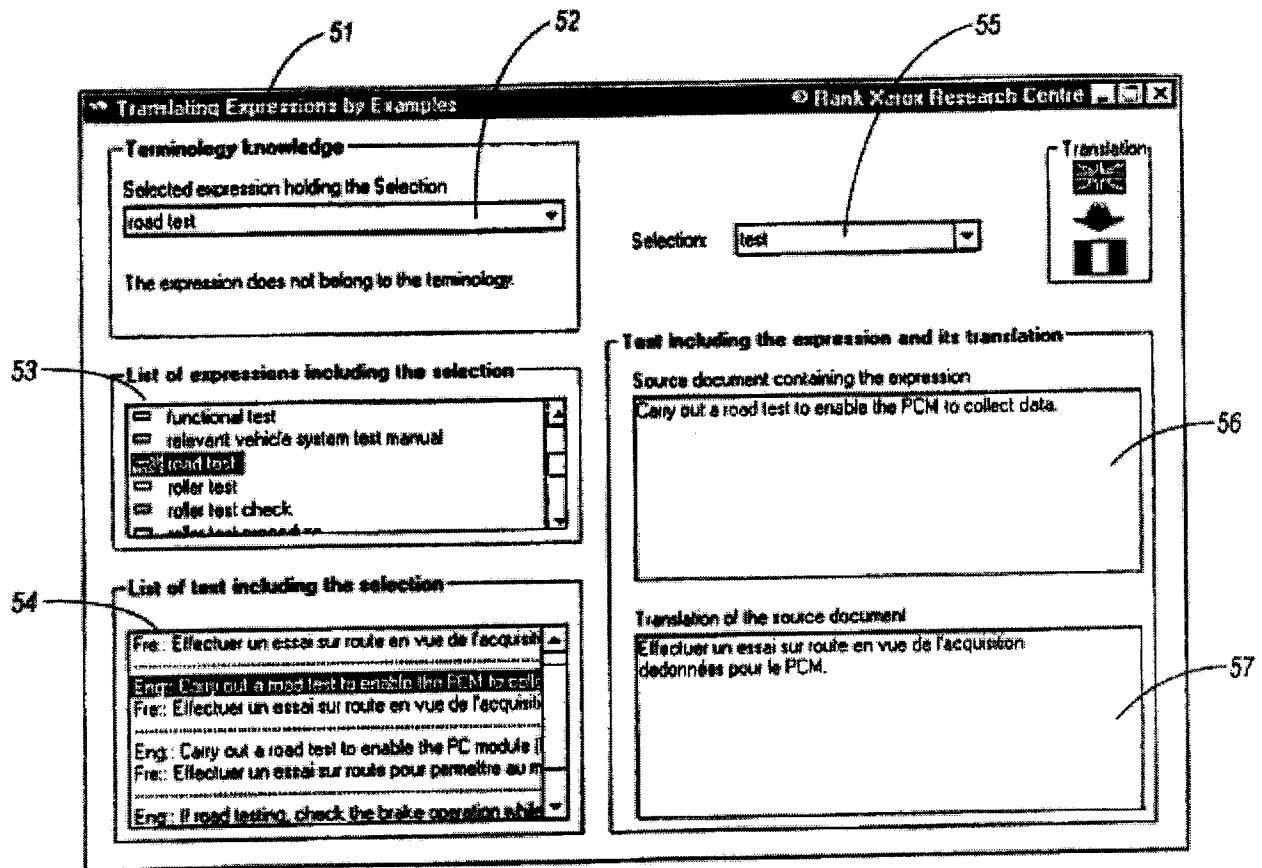
“[w]hich illustrate a flow chart of the translation process, **the user inputs the text to be translated in step 31.** (emphasis added) The text is then displayed so that the user can select an unknown word or group of words, e.g. by double-clicking on the word. Once a word has been selected in step 32, phrase extractor 15 extracts in step 33 all the possible noun phrases relating to the selected word. The set of possible noun phrases is then displayed in step 34, and one of the displayed noun phrases is selected, in step 35, either automatically or by user request. By default, longest of the extracted noun phrases is selected, with no need of user selection. This automated selection may also be performed depending on whether the extracted noun phrases exist in the database. In this case, the longest (sub) noun phrase existing in the database is selected. In any case, selection may be performed or changed by the user.”

Gastaldo is related to assisting a translator in getting appropriate translation for any phrase<sup>5</sup>. To achieve this goal, Gastaldo, apparently establishes a database of corresponding text fragments in different languages by aligning text fragments in the source and target manually translated documents. Gastaldo inputs a first document containing a text written in the first language; inputs a second document containing said text written in the second language; aligns corresponding text fragments of the first and second documents; extracts word phrases from the text fragments of the first document; and generates index information on the extracted word phrases and the **aligns text fragments holding the word phrases**<sup>6</sup>. FIG 5, referred to by the Final Office Action, is illustrated below.

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<sup>5</sup> Gastaldo, column 1, line 7

<sup>6</sup> Gastaldo, column 2, lines 49 – 58

**FIG. 5**

In addition, the Final Office Action alleges that Flanagan teaches “*said translated language construct is generated and stored, and said correspondence to said selected language construct is defined, prior to communications of said plurality of language constructs to said first entity as said first transmissions*”<sup>7</sup>.

Applicant respectfully disagrees. Flanagan relates messages that are posted to a discussion group, periodically collected, translated to other languages, and posted to target language discussion groups. The messages that are collected are sent to an automatic Machine Translation (MT) software for translation<sup>8</sup>. Accordingly, Flanagan relates a translation that occurs after the messages are posted. In contrast, claim 1 requires a translated language construct and a correspondence to a language construct that is defined prior to communication of

<sup>7</sup> The Final Office Action, Page 5

<sup>8</sup> Flanagan, column 2, lines 35 – 43

the language construct to the first entity. Clearly, these systems operate in ways that are fundamentally different.

Even when combined Flanagan and Gastaldo may not be said to suggest to one of ordinary skill in the art the above quoted limitations of claim 1 or provide a basis for inferring the above quoted limitations of claim 1. Moreover, it is unclear what rational underpinning could possibly support the legal conclusion of obviousness in reaching the limitations of claim 1. Specifically, the MPEP states that Office personnel *must explain why the difference(s) between the prior art and the claimed invention would have been obvious* (emphasis added) to one of ordinary skill in the art. MPEP § 2141. Applicant respectfully points out that no such explanation is provided in the Final Office Action. Indeed, the Final Office Action is silent with respect to why the differences between the combination of Flanagan and Gastaldo and the claimed invention would have been obvious to one of ordinary skill in the art at the time of invention. Applicant respectfully submits that the Final Office Action has failed to establish a *prima facie* case of obviousness.

#### COMBINING FLANAGAN AND GASTALDO WOULD DESTROY THE STATED PURPOSE OF FLANAGAN

According to the Final Office Action, it would be obvious to one of ordinary skill in the art, at the time the invention was made, to combine Gastaldo with Flanagan. The Final Office Action reasons that utilizing predetermined phrases in a database situation could aid in a faster translation since no real “translation” is occurring<sup>9</sup>.

Combining Flanagan with Gastaldo by altering Flanagan to include predetermined phrases in a database situation, as suggested by the Final Office Action, would destroy the stated purpose of Flanagan. According to Flanagan, its purpose is to assist electronic discussion group users by utilizing existing translation software. According to Flanagan, messages posted to a discussion group will be periodically collected, translated to other languages, and then posted to those respective target language discussion groups. The new messages that are collected on a periodic basis are sent to commercially available automatic Machine Translation (MT) software

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<sup>9</sup> The Final Office Action, page 4

for translation<sup>10</sup>. Thus, Flanagan requires utilization of third party automatic translation in order to synchronize multilingual forums. Furthermore, Flanagan is intended for forum users only familiar with their native language.<sup>11</sup>

Gastaldo, on the other hand, is related to assisting in translating documents and requires manual input from translators skilled in more than one language. Requiring forum users of Flanagan to select language structures of an unfamiliar language would destroy its purpose of facilitating communications with respect to multi-language forums. Accordingly, Applicant respectfully requests that the obviousness rejection of claim 1 be withdrawn.

Independent claims 12, 23 and 34 are of scope similar to the scope of claim 1. In view of the arguments presented above with respect to claim 18, Applicant respectfully requests the obviousness rejection of claims 12, 23 and 34 be withdrawn.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 4-5, 9-11, 15-16, 20-22, 26-27, 31-33, 37-38 and 42-45 under 35 U.S.C. § 103 is also addressed by the above remarks.

*Concerning claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48:*

Claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flanagan in view of Gastaldo, and further in view of Scanlan (U.S. Patent No. 6,857,022).

Applicant respectfully submits that the rejection of claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48 under 35 U.S.C. § 103 is defective for the reason that a person of ordinary skill in the relevant field in determining the scope and content of the cited documents and understanding the differences between the cited documents and the independent claims of the present application would not conclude the independent claims are obvious

Applicant submits that Flanagan and Gastaldo fail to disclose or suggest elements of claims 1, 12, 23 and 34 from which claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48 depend. Indeed, the Final Office Action alleges that Scanlan discloses elements peculiar to

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<sup>10</sup> Flanagan, column 2, lines 35 – 43

<sup>11</sup> Flanagan, column 1, line 57

claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48 but is silent as to why Flanagan, Gastaldo, and Scanlan when combined would teach or suggest elements not disclosed by the combination of Flanagan and Gastaldo. Moreover, the Final Office Action has failed to explain why the differences between the combination of Flanagan, Gastaldo, and Scanlan and the rejected claims would render the rejected claims obvious to one of ordinary skill in the art.

For the above reasons Applicant respectfully requests that the obviousness rejection of claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48 be withdrawn.

*Concerning claims 8, 19, 30 and 41:*

Claims 8, 19, 30 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flanagan in view of Gastaldo, and further in view of Christy (U.S. Patent No. 6,301,554).

Applicant respectfully submits that the rejection of claims 8, 19, 30 and 41 under 35 U.S.C. § 103 is defective for the reason that a person of ordinary skill in the relevant field in determining the scope and content of the cited documents and understanding the differences between the cited documents and the independent claims of the present application would not conclude the independent claims are obvious. Moreover, the Final Office Action has failed to explain why the differences between the combination of Flanagan, Gastaldo, and Christy and the rejected claims would render the rejected claims obvious to one of ordinary skill in the art.

For the above reasons Applicant respectfully requests that the obviousness rejection of claims 8, 19, 30 and 41 be withdrawn.

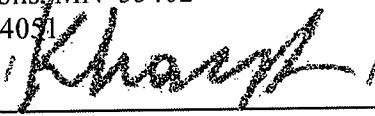
**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-278-4051 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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